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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,822	02/15/2002	Thorsten Krawinkel	tesa AG 1516-KGB	2017

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KURT BRISCOE  
NORRIS, MCLAUGHLIN & MARCUS, P.A.  
220 EAST 42ND STREET, 30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
  - Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some\* ☐ None of the:

- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It appears to be a xerox copy which has an illegible signature and date of execution and as such is believed to be clearly defective.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, applicant's claims appear to contain a great number of translation related informalities and the like and need to be substantially revised, if not entirely rewritten. Some, but not all of these admissions are as follows: In claim 1 the phrase "sheet strip for a bond" is both redundant and also not understandable. In claims 3-6 and 8 multiple embodiments are set forth in "preferably" or the like clauses. Claim 9 is not understandable in its revised form.

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4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions in the specification beginning at page 1 and extending through the middle paragraph on page 2, as well as page 9, last three lines - page 10, lines 1 and 2, the admissions taken in view of Gergen et al. The Examiner essentially believes that applicant has admitted that the various elements of his claimed invention are well known, that is, stretch release adhesive tapes that can have a pressure sensitive adhesive based on an elastomer that has been modified with acids and/or acid anhydrides, with the major missing element being the presence of any motivation to combine the two into forming a genus of stretch releasable adhesive tapes such as applicant claims. However, the secondary reference discloses (note particularly column 1, lines 6-14, lines 27-34, column 2 lines 38-62, column 4 lines 24-32, column 5 lines 39-51, column 6 lines 38-50, column 7 lines 17-21, column 8 lines 40-46,

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and TABLE 1) the fact that elastomeric block copolymers such as SEBS and the like are desirably modified with acid compounds or derivatives such as maleic anhydride and its derivatives (column 7 lines 17-20) that result in a wide variety of desirable properties, particularly (column 1 lines 9-10, column 2 lines 39-43, column 4 lines 29-30) desirable adhesion and appearance properties in the resultant articles and substrates upon which they are adhered. Accordingly, one of ordinary skill, motivated by an expectation of attaining the aforementioned improved performance properties taught in Gergen et al. would have no difficulty in substituting the acid modified or acid anhydride-modified elastomers taught as known on pages 9-10 of the specification and incorporate them into the sheet or tape embodiments which are also admitted by him to be old and thereby produce the claimed genus of adhesive articles. What other parameters, such as the range of proportions of the various elements (claims 3 and 4) and presence of further additives and tackifiers (claim 5) are each believed to be, if not either expressly or inherently disclosed, obvious optimization parameters to one of ordinary skill, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Korpman, Hamerski et al. and Kreckel et al., each cited by

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applicant in his specification, the U.S. patent application publication to the inventor 2002/0197470A1, a U.S. statutory invention registration (SIR) to Gelles, and an English language Abstract of DE 3331016.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

May 29, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-

1700

*Daniel Zirker*